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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,762	10/12/2001	Margaret Shipp	DFN-031US	2130

959 7590 02/04/2003

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

WINKLER, ULRIKE

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 02/04/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,762

Applicant(s)

SHIPP ET AL.

Examiner

Ulrike Winkler, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1648

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10 and 20, drawn to an isolated nucleic acid (SEQ ID NO: 1 and 3) that encodes a polypeptide (SEQ ID NO:2).

Group II, claim(s) 1-10 and 20, drawn to an isolated nucleic acid (SEQ ID NO: 4 and 6) that encodes a polypeptide (SEQ ID NO:5).

Group III, claim(s) 11-13, drawn to an isolated polypeptide, SEQ ID NO:2.

Group IV, claim(s) 11-13, drawn to an isolated polypeptide, SEQ ID NO:5.

Group V, claim(s) 14 and 17, drawn to an antibody that recognizes the polypeptide, SEQ ID NO:2.

Group VI, claim(s) 15-16, drawn to a method of detecting the polypeptide of SEQ ID NO:2.

Group VII, claim(s) 14 and 17, drawn to an antibody that recognizes the polypeptide, SEQ ID NO:5.

Group VIII, claim(s) 15-16, drawn to a method of detecting the polypeptide of SEQ ID NO:5.

Group IX, claim(s) 18-19, drawn to a method of detecting the nucleic acid of SEQ ID NO:1 and 3 or a nucleic acid encoding the polypeptide of SEQ ID NO:2.

Group X, claim(s) 18-19, drawn to a method of detecting the nucleic acid of SEQ ID NO:3 and 6 or a nucleic acid encoding the polypeptide of SEQ ID NO:5.

Group XI, claim(s) 21-24 drawn to a method of identifying a compound that binds or modulates the activity of the polypeptide of SEQ ID NO:2.

Group XII, claim(s) 21-24 drawn to a method of identifying a compound that binds or modulates the activity of the polypeptide of SEQ ID NO:5.

Art Unit: 1648

The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because under unity of invention between different categories of inventions will only be found to exist if specific combinations of inventions are present. Those combinations include:

- A) A product and a special process of manufacture of said product.
- B) A product and a process of use of said product.
- C) A product, a special process of manufacture of said product, and a process of use of said product.
- D) A process and an apparatus specially designed to carry out said process.
- E) A product, a special process of manufacture of said product, and an apparatus specially designed to carry out said process.

The allowed combinations do not include multiple products, multiple methods of using said products, and a method of making a product as claimed in the instant application.

The special technical feature of group I is the nucleic acid of SEQ ID NO 1 and 3.

The special technical feature of group II is the nucleic acid of SEQ ID NO 4 and 6.

The special technical feature of group III is the isolated polypeptide of SEQ ID NO 2.

The special technical feature of group IV is the isolated polypeptide of SEQ ID NO 5.

The special technical feature of group V is an antibody that recognizes SEQ ID NO: 2.

The special technical feature of group VI is a method of detecting SEQ ID NO: 2.

The special technical feature of group VII is an antibody that recognizes SEQ ID NO: 5.

The special technical feature of group VIII is a method of detecting SEQ ID NO: 5.

The special technical feature of group IX is detecting the nucleic acid of SEQ ID NO: 1 and 3.

The special technical feature of group X is detecting the nucleic acid of SEQ ID NO: 4 and 6.

The special technical feature of group XI is the method of identifying a compound that binds or modulates the activity of the polypeptide of SEQ ID NO:2.

The special technical feature of group XII is the method of identifying a compound that binds or modulates the activity of the polypeptide of SEQ ID NO:5.

Accordingly, Groups I-XII are not so linked as to form a single general inventive concept and restriction is proper.


Art Unit: 1648

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Ulrike Winkler, Ph.D. 2/13/03